

Appln. No. 09/991,096
Amendment dated September 7, 2006
Reply to Office Action mailed June 7, 2006

BEST AVAILABLE COPY**REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 34 remain in this application. No claims have been cancelled or withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 2 of the Office Action

Claims 1, 10, 12 and 32 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 1, 10, 12 and 32 is therefore respectfully requested.

Paragraph 3 through 5 of the Office Action

Claims 1 through 17, 19 through 26, 29 and 31 through 34 have been rejected under 35 U.S.C. §102(e) as being anticipated by Davenport.

Claims 18, 27 and 28 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Davenport in view of Official Notice.

Initially it is noted that the Davenport patent was filed after the filing date of the present patent application, and thus the rejection of the claims of this patent application must rely upon the filing date of the provisional patent application that is referenced in the Davenport patent. It is noted that the disclosure of the Davenport patent (and thus the underlying non-provisional patent application) is much more extensive than the disclosure

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of the provisional patent application. Applicant does not concede that the disclosure of the Davenport provisional patent application supports the points of the rejections, but as noted below it is not believed that the Davenport patent supports the points of the rejection, and thus discussion of the support in the provisional patent application is not addressed. However, applicant reserves the right to argue that the Davenport provisional patent application does not provide support for the points of the rejection that are presently addressed in terms of the disclosure of the Davenport patent. Nevertheless, due to the necessary reliance on the Davenport provisional patent application for a filing date that precedes the filing date of the present patent application, it is believed that support for the points of the rejections should be pointed out in the Davenport provisional patent application.

Claim 1 requires in part "a user personal computer configured to detect and upload data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*" (emphasis added).

It is contended in the rejection of the Office Action that the Davenport patent teaches this requirement of claim 1 at col. 2, line 41 through col. 3, line 25 and at col. 11, line 33 through col. 12, line 16, alleging that "Davenport discloses a system capable of detecting user interaction with a computer and uploading that data." However, it is submitted that 1) the language of claim 1 does not merely require a system merely "capable of" detecting user interaction (but instead requires "a user personal computer *configured to detect and upload data characterizing a user's interaction with the user personal computer during an initial setup of the user personal computer*"), that 2) the Davenport patent makes no mention or suggestion of detecting *user interaction* with the personal computer, and that 3) the Davenport patent makes no mention or suggestion of any detecting or uploading of data that characterizes "a user's interaction with the user

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personal computer *during an initial setup of the user personal computer*”

More specifically, and turning to the first cited portion of the Daenport patent at col. 2, line 41 through col. 3, line 25, it states (emphasis added):

To address these and other needs, the present invention provides a method for enabling a software manufacturer to record a set of data points about a computer while it is executing an application. The data points contain measurements concerning a status, condition, action, event or other measurable property about the computer. The data point information is thereafter transmitted to a central computer for analysis so that the manufacturer can obtain timely and precise feedback about how its application is being used. The method of the present invention is thus well-suited to obtaining and processing computer usage information involving millions of computers.

The present invention is accomplished by executing on a local computer, such as one belonging to a customer, a software program that has been adapted to measure predetermined parameters about the usage, performance or status of the computer on which the application is running. Such an application is hereinafter termed an “instrumented application.” The parameters to be measured are determined by the software manufacturer and could include information such as the processor speed of the computer system, the amount of its random access memory or the speed of the computer's Internet access. Upon execution, the instrumented application initiates an instrumentation session and obtains an identifier. The identifier is an alphanumeric or numeric value that identifies the local computer user or the local computer itself. The instrumented application then measures the predetermined parameter to obtain a value and stores a data point on the computer identifying the parameter and the value. The present invention contemplates data points that store a single value as well as a series of values. A single value data point records a numeric or alphanumeric value, such as the amount of the computer's random access memory (RAM). A series of values, or stream, data point contains a series of numeric or alphanumeric values whereby the order of the values within the stream indicates the order in which the events or other parameters occurred, such as a list of clickable links the user selected. Additionally, data points in either form may be supplied with a time stamp indicating the time at which the data point was measured. Parameters can be measured until the instrumentation session ends, which occurs when the user exits from the instrumented application or as otherwise provided by the software manufacturer.

When an instrumentation session ends, the identifier and the data points collected during that session are saved in a session file on the local computer. The method of the present invention then attempts to transmit the session file to an upload server computer for further processing. If the session file is transmitted, it is then deleted from the local computer; otherwise, the session file is retained for possible later attempted transmission.

However, nothing here discloses or suggest that the Davenport system “detect[s] and upload[s] data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*”, as required by claim 1. The examples given in the text (and highlighted above) relate to the performance of the computer (“processor

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speed", "amount of its random access memory" and "speed of the computer's Internet access") and not to the *user's interaction* with the personal computer, as these examples are things that are basically independent of the user's actions. Nor are the examples given directed to user interaction occurring "during an initial setup of the user personal computer" as also required by claim 1. Furthermore, the Davenport "data points" are measured "until the instrumentation session ends", which suggests to one of ordinary skill in the art that there is no particular stage of operation when the data points are measured. It is submitted that the examples given are more likely to lead one of ordinary skill in the art *away from* the claimed user interaction with the computer during an initial setup" rather than leading one to this requirement. The rejection of the Office Action further references the Davenport patent at col. 11, line 33 through col. 12, line 16, where the Davenport patent states:

At step 250, the instrumentation session is complete, and the instrumented application ends the instrumentation session by ceasing to measure parameters for this instrumentation session. The application thereupon saves the set of data points along with the identifier in a session file on a local storage device accessible by the local computer. The local storage device may be the hard disk of the local computer, a removable memory device associated with the local computer or other storage medium associated with the local computer. The local storage device could likewise be a storage device to which the local computer has access via a network, such as on a LAN server. As will be appreciated by those skilled in the art, the session file could be further subjected to file compression to decrease transmission times.

The session file could further be named to facilitate management of session files awaiting transmission to a remote computer. For example, the session file could be stored as a file named SESSIONnnn.DAT, where -nnn- represents a number between a selected range, such as 1 and 10. The range can be selected to correspond to the maximum number of untransmitted session files to be stored at any one time on the local storage device. When a new session file is to be saved, the instrumented application would use an available file name. Thus, when the instrumented application seeks to store a current session file and, for example, the file SESSION001.DAT already exists, the instrumented application could save the current session file to SESSION002.DAT if no existing file had yet used this name. If the maximum number of stored session files had been reached, the instrumented application could delete the file containing the oldest session data and store the current session file, thereby conserving disk space.

After the session file has been stored, control passes to step 252 at which point the application directs the local computer to transmit the current session file to a remote computer or upload server 206 via a network, such as network 204. The network could be a

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local area network or a wide area network, such as the Internet. As will be understood by those skilled in the art, the transfer could be accomplished expeditiously using an HTTP POST or HTTPS POST request to the upload server 206 that transmits the data in binary form. The application determines at step 254 whether the session file was transmitted to the remote computer. If so, control passes to step 256 and the session file is deleted from the local storage device to conserve storage space. If the transmission of the current session file did not occur, it is retained on the local storage device so that when the next instrumentation session is started, a further attempt at transmission of this session file can be made. Regardless of whether the session file is transmitted, control passes to step 258 at which point processing is completed.

Again, nothing here describes or suggests that there is any detection or unloading of "data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*". In fact, the text here (especially in combination with the text cited above) leads one of ordinary skill in the art to believe that the "data points" that are recorded occur after any initial setup of the computer, as the detection of processor speed and Internet access speed are certainly more meaningful after an initial setup than during an initial setup of the personal computer. (A review of the disclosure of the provisional patent application fails to show any further description that would lead one of ordinary skill in the art to the elements of claim 1 that are missing in the Davenport patent.)

It is therefore submitted that the Davenport patent could not lead one of ordinary skill in the art to the combination of requirements of claim 1, particularly the elements addressed above.

Similarly, claim 10 requires in part "a user personal computer configured to detect and upload data related to a user's out-of-box interaction with the user personal computer during initialization". Claim 12 requires "providing the user personal computer with a capability of detecting data related to a user's interactions with the personal computer", "initializing the user personal computer including user interaction detecting capability, by the user", and "*detecting, during the initializing by the user, data related to the user's interactions with the personal computer during*

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initialization" (emphasis added). Claim 20 requires "*detecting an initialization* of a user when the user sets up a user personal computer", "*saving the initialization activity detected* in said detecting step to a file" and "*uploading the file* to an originator of the user personal computer wherein the initialization activity of the user is correlated by the originator" (emphasis added). Claim 22 requires "a second software program configured to cause the user personal computer to *detect and compile the user's initial interactions* with the personal computer performing the first software program" and "wherein the second software program is configured to cause the user personal computer to upload the compiled data to a remote information handling system". Claim 23 further requires "means for detecting *an initialization activity* of a user when the user initializes a personal computer", "means for *saving the initialization activity detected* by said monitoring means to a file", and "means for uploading the file to an originator of the user personal computer wherein *the initialization activity of the user is correlated by the originator*" (emphasis added).

It is therefore submitted that the Davenport patent would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1, 12, 20, 22 and 23 especially with the requirements set forth above, and therefore it is submitted that claims 1, 12, 20, 22 and 23 are allowable over the prior art. Further, claims 2 through 11, 25, 26, 29 and 31, which depend from claim 1, claims 13 through 17, 19 and 32 through 24, which depend from claim 12, claim 21, which depends from claim 20 and claim 24, which depends from claim 23 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §102(e) and §103(a) rejections of claims 1 through 34 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



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Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. **40,158**
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357